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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,317	06/08/2001	John J. Sie	19281-001610	9420
20350 7590 07/10/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
BOUTAH, ALINA A				
ART UNIT		PAPER NUMBER		
2143				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/877,317

Applicant(s)

SIE ET AL.

Examiner

ALINA N. BOUTAH

Art Unit

2143

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 and 19-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 19-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 3/19/08

DETAILED ACTION

Response to Amendment

This action is in response to Applicant's amendment filed March 26, 2008. Claims 1-8 and 16-18 have been cancelled. Claims 28-32 have been newly added. Claims 9-15 and 19-32 are pending in the present application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose "wherein determining if any first segment of the plurality of programs are not already stored and recording any first segment that is not already stored are performed before any user request for any of the plurality of programs" as amended. Applicant is requested to point out where in the specification this is disclosed .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-15 and 19-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,729,280 issued to Inoue et al.

Regarding claim 9, Inoue teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

recording any first segment of each of the plurality of programs that are not already stored (col. 8, lines 35-62: recording remaining segments of program);

detecting the user request for one of the plurality of programs (col. 8, lines 35-62: user directing programs to be pre-recorded); and

recording a second segment of the one of the plurality of programs in response to the detecting step (col. 8, lines 35-62: recording pre-storage of the video program as directed by user).

Although Inoue does not explicitly teach determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored, it would have been obvious to one of ordinary skill in the art to determine if any of a first segment of a program is not already stored and recording a

segment that is not already stored because doing so will allow only segments that are needed to be recorded, thus saving storage space.

Regarding claim 10, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of recording any remaining segments of the one of the plurality of programs (col. 8, lines 35-62).

Regarding claim 11, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment is sent on a first digital channel and the second segment is sent on a second digital channel (figure 2).

Regarding claim 12, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders (figure 1).

Regarding claim 13, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs (abstract).

Regarding claim 14, although Inoue does not explicitly teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of: receiving a wireless request from a remote control; and processing the wireless request to determine a desired program, he teaches receiving request from user's controlling device, which in this case could be wired or wireless (col. 2, line 58 to col. 3, line 13).

Regarding claim 15, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (figure 1).

Regarding claim 19 (amended), Inoue teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording a first segment of a plurality of the programs sent from the content provider before any user request for the program (col. col. 8, lines 35-62: pre-stored program; col. 9, lines 31-38 – pre-storing preview clips; figures 4A-4B: pre-storing programs a-c);

detecting the user request for selected program of the plurality of programs (col. 6, lines 14-24: user requests that program be received); and

recording a second segment of the selected program if the user request is detected before a stagger period expires wherein the period is less than a duration of the program (col. 8, lines 35-62: recording the rest of the program; figure 4A – user's request is detected at T6 before a period (of 5 mins) is expired, channel 3 records program a3).

Although Inoue does not necessarily teach recording a first segment of all of the plurality of programs, he teaches recording a plurality of programs as cited above. One of ordinary skill in the art would have recognized that this is an obvious variation of Inoue. it would have been obvious to record all programs in order to allow users to view all of available contents, thus giving user more choices.

Regarding claim 20, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step comprises a step of detecting the user request for the program during the step of recording the first segment (col. 8, lines 35-62).

Regarding claim 21, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location (col. 4, lines 36-46).

Regarding claims 22 and 25, Inoue teaches wherein the first segment of each of the plurality of programs is sent from the content provider once (figure 4A).

Regarding claims 23 and 26, Inoue teaches wherein the first segment of each of the plurality of programs are sent from the content provider on the same channel (figure 4A).

Regarding claims 24 and 27, Inoue teaches wherein the second segment of the selected program is sent from the content provider more than once and on more than one channel (figure 4A).

Regarding claims 28 and 29, Inoue teaches wherein the second channel does not send the first segment and the first digital channel does not send the second segment (figure 2A – i.e. each of the segments are being sent from different channels).

Regarding claim 30, Inoue teaches wherein the first segment is sent only once (figure 2A).

Regarding claim 31, Inoue teaches wherein the first segment is sent via a first delivery mechanism and the second segment is sent via a second delivery mechanism (i.e. broadcast system such as cable).

Regarding claim 32, Inoue teaches wherein first delivery mechanism comprises a cable television network. However, Inoue does not explicitly teach the second delivery mechanism comprising a broadband network connection. Nevertheless, one of ordinary skill in the art would recognize that is obvious since broadband is known to be one of many mechanisms that deliver videos. One of ordinary skill in the art would have been motivated to employ broadband because it is cheap, fast and reliable.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In response to Applicant's argument in claim 9 that Inoue fails to teach i.e. recording all first segments, the PTO respectfully submits that this feature is not claimed in the claim language.

Regarding claim 19, Applicant argues that Inoue fails to teach "recording a first segment of all a plurality of programs sent from the content provider before any user request for the program," as stated above in the rejection, Inoue teaches recording a first segment of a plurality of programs sent from the content provider, but not necessarily all of the program. One of ordinary skill in the art would recognize that this is an obvious variation of the teaching of Inoue.

It would have been obvious to record all of programs as opposed to some in order to provide all of the programs to the user, thus allowing the user more selection choices.

Regarding newly added claims, Inoue, in figures 2A and 4A for example teach that each of the segments are being sent from different channels.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALINA N. BOUTAH whose telephone number is (571)272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. N. B./
Examiner, Art Unit 2143

/Nathan J. Flynn/
Supervisory Patent Examiner, Art Unit 2154

Application Number

Application/Control No.

09/877,317

Examiner

ALINA N. BOUTAH

Applicant(s)/Patent under
Reexamination

SIE ET AL.

Art Unit

2143